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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,782	10/19/2000	Scott R. Smith	760-3 RES	3708

7590

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EXAMINER

THALER, MICHAEL H

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 01/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/691,782**

Applicant(s)  
**Smith et al.**

Examiner  
**Michael Thaler**

Art Unit  
**3731**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14 is/are allowed.
- 6) ☒ Claim(s) 15-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

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Certificate of Correction changes made in the patent must be incorporated into the reissue application. However, note that these changes must be made without underlining or bracketing..

The request to transfer the drawings from the patented file is denied since the Office no longer permits such transfers. However, the drawings submitted in this application are acceptable.

Applicant is requested to submit a PTO-1449 form including all references cited in the patent.

Claims 15-21 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. During the original prosecution of

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applicant's patent (Patent No. 5,824,046), originally filed claims 1-23 were rejected by the examiner in the Office Action mailed April 17, 1997, as being unpatentable over Myers et al. (WO 95/05132) in view of Hubis (4,478,665) under 35 U.S.C. 103(a). In an amendment filed Oct. 20, 1997 replying to that Office Action, applicant added the limitation to claim 1:

"wherein said stent covering includes an elongate segment of said unsintered, ePTFE having an original longitudinal expanse, said segment being expanded in a transverse direction so as to reduce said original longitudinal expanse, said segment being positioned generally transverse to said longitudinal stent axis, and being expandable longitudinally upon said radial expansion of said stent to return said expanded segment to said original longitudinal expanse to thereby control said radial expansion of said stent".

On pages 4-7 of that amendment, applicant argued that the claims were patentable because the above limitation was not found in the prior art. In the reasons for allowance, the examiner indicated that the claims were patentable essentially because the above limitation was not found in the prior art. Claims 15-21 of the present application fail to include this limitation. Since applicant narrowed the claims for the purpose of obtaining allowance in the original prosecution, applicant is now precluded from recapturing subject matter previously surrendered.

Claims 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al. (WO 95/05132) in view of Hubis (4,478,665). Myers et al. show stent 10 and stent cover 20 formed of ePTFE having a longitudinal expanse and a transverse expanse which is expandable along said transverse expanse upon radial

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expansion of stent. Myers et al. fail to show the ePTFE as being unsintered. Hubis teaches that ePTFE articles such as films and tubes used in the medical field may be unsintered rather than sintered (col. 1, lines 20-30 and col. 3, lines 45-46). This results in the self-evident advantage of not having expend the time, energy and money involved in the sintering process. It would have been obvious to use unsintered ePTFE as the material for the Myers stent cover 20 so that it too could enjoy this advantage.

Claims 15-17 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Banas et al. (5,749,880). Banas et al. show stent 10 and stent cover 26 formed of unsintered ePTFE (col. 13, lines 34-41). Although the stent cover 26 is later sintered (col. 13, lines 56-57), the Banas et al. stent and stent cover prior to this sintering meet the limitations of the claims.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banas et al. (5,749,880). Banas et al. fail to show the stent cover having a seam formed by opposing overlapping edges. Including such a seam in the Banas et al. stent cover in order to conveniently secure the stent cover on the stent would have been obvious, particularly since it is well known in the art to so construct stent covers for this reason.

Claims 1-14 are allowed.

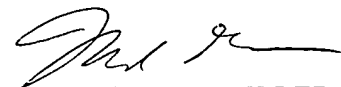
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

mht  
January 7, 2002  
FAX (703) 305-3590



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731

Attachment for PTO-948 (Rev. 03/01, or earlier)  
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.